REMARKS

I. CLAIM STATUS

Claims 20-38 are currently pending. Claim 20 has been amended to recite, in relevant part, "wherein the process operates continuously from the feeding step through the forming step without any intermediate resting or collecting steps." Support for the amendment can be found in the specification and claims as-filed. Accordingly, this amendment raises no issue of new matter.

II. REJECTIONS UNDER 35 U.S.C. § 103(a)

A. The Office continues to reject claims 20-29, 33, and 36-37 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,225,749 to Pierre et al. ("Pierre") in view of WO 99/33070 to Belli et al. ("Belli") and in further view of WO 02/27731 to Castellani et al. ("Castellani") for the reasons of record.[1] *See* April 10, 2009, Final Office Action at 2-6 and 9-10. Specifically, in response to Applicants' arguments of December 11, 2008, that Pierre does not teach a continuous process, the Office alleges that "Pierre teaches a continuous process of manufacturing cable, although the entire process from beginning to end is not continuous." *See id.* at 9.

Applicants respectfully disagree with and traverse this rejection for at least the reasons of record, as well as the following additional reasons.

Several basic factual inquires must be made in order to determine the obviousness or non-obviousness of claims of a patent application under 35 U.S.C.

[1] The Office relies on U.S. Patent No. 6,824,870 as a translation of WO/02/27731. All references herein to Castellani refer to the U.S. patent.

§ 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

(1) Determine the scope and content of the prior art;

(2) Ascertain the differences between the prior art and the claims in issue;

(3) Resolve the level of ordinary skill in the pertinent art; and

(4) Evaluate evidence of secondary considerations.

The obviousness or nonobviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. at 467; *see also KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1730, 82 U.S.P.Q.2d 1385, 1388 (2007).

Indeed, to establish a *prima facie* case of obviousness, the Office must:

> make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

M.P.E.P. § 2142. "The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." *Id.* Moreover, each prior art reference relied upon in a rejection "must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." M.P.E.P. § 2141.03(VI) (emphasis in original); *see also Graham*, 383 U.S. at 17, 148 U.S.P.Q. at 467.

In view of the relevant law, Applicants note that as amended, the claims of the instant application are drawn to a continuous process and explicitly recite, in relevant part, that "the process operates continuously from the feeding step through the forming step without any intermediate resting or collecting steps." None of the references relied on by the Office teach or suggest such a process.

At a minimum, the Office has erred in its determination of the scope and content of the prior art and the differences between the prior art and the instant claims. In particular, Pierre does not teach or suggest a continuous process that "operates continuously from the feeding step through the forming step without any intermediate resting or collecting steps[,]" as recited in claim 20. The Office admits this fact. *See* April 10, 2009, Final Office Action at 9 ("the entire process [of Pierre] from beginning to end is not continuous.").

Rather, Pierre teaches, especially in Figure 2, that cable **12** (including conductor **1**, insulator **3**, and extruded screens **2** and **4**) is manufactured and set on reel **11** which is later used for paying out cable **12** such that metal strip **14** can be folded around cable **12** by means of a shaping device **17**. *See* Pierre at Fig. 2 and col. 2, lines 40-56. By setting cable **12** on reel **11** after manufacturing it, Pierre's method includes a resting step and thus, does not constitute a continuous process that "operates continuously from the feeding step through the forming step without any intermediate resting or collecting steps[,]" as recited in claim 20. In fact, nothing in Pierre teaches that the process to create cable **12**, before the addition of the metallic screen, was a continuous process. Thus, the Office's argument that Pierre teaches a continuous process is mere supposition.

Since Pierre teaches a resting/collecting step and there is no evidence that Pierre teaches a continuous process from feeding to cooling, Pierre does not teach each and every element of the claims.

Belli and Castellani do not remedy Pierre's deficiencies. Indeed, the Office implicitly admits this fact by relying solely on Pierre for its alleged disclosure of a continuous process, while relying on Belli and Castellani for their alleged disclosure of other aspects of the instant claims. Accordingly, the instant claims are patentable over Pierre, Belli, and Castellani, at least because those references fail to teach or suggest a continuous process that "operates continuously from the feeding step through the forming step without any intermediate resting or collecting steps[,]" as recited in claim 20.

Further, none of the cited documents disclose a continuous process comprising, in relevant part, "forming a circumferentially closed metallic screen around said extruded insulating layer" after "cooling the extruded insulating layer to a temperature not higher than 70°C[,]" as recited in claim 20. The Office admits that neither Pierre nor Belli disclose the circumferentially closed metallic screen. *See* April 10, 2009, Final Office Action at 3. To correct this deficiency, the Office relies on Castellani, stating that "Castellani teaches a method for producing cable [abstract lines 1-2] comprising a conductive core (2) insulator shield (4) and a circumferentially closed metallic shield . . . (6) [fig. 1, column 8, lines 41-48]." *Id.*

In making this assertion, the Office implies that Castellani's metallic shield is placed on a cable core in a continuous process *after* the cable is cooled down to room temperature. Applicants disagree. While Castellani generally describes a cable having

screen **6,** it does not mention or suggest the screen is added to semiconductive layer **5** after cooling. *See* Castellani at col. 8, lines 41-48. Castellani also describes another cable that is cooled to ambient temperature once it leaves the extrusion head, but that cable does *not* include a metallic screen. *See id*, col. 11, lines 11-14 and Table 2 (describing the materials used in the finished cable and not including a metallic shield). For at least this additional reason, the combination of Pierre, Belli, and Castellani does not render the instant claims obvious, because the references fail to teach or suggest each and every element of the instant claims.

Accordingly, for at least the reasons of record and the reasons presented above, Applicants respectfully submit that the 35 U.S.C. § 103(a) rejection of claims 20-29, 33, and 36-37 as being allegedly unpatentable over Pierre, Belli and Castellani is improper, and should be withdrawn.

B. The Office continues to reject claims 30, 33, and 34 under 35 U.S.C. § 103(a) as being unpatentable over a combination of Pierre, Belli, Castellani, and U.S. Patent No. 6,501,027 to Belli et al. ("the '027 patent") for the reasons of record. *See* April 10, 2009, Final Office Action at 6-7 and 9-10.

Applicants respectfully disagree with and traverse this rejection for at least the reasons for record, as well as the following additional reasons.

As discussed above, Pierre, Belli and Castellani fail to disclose each and every element of independent claim 20, whether considered alone or in combination. In particular, those references fail to teach or suggest a method that "operates continuously from the feeding step through the forming step without any intermediate resting or collecting steps[,]" and which included "forming a circumferentially closed

metallic screen around said extruded insulating layer" after cooling the extruded insulating layer, as recited in claim 20.

The '027 patent does not cure these deficiencies, as tacitly admitted by the Office's reliance on the disclosure of the '027 patent for other purposes. Accordingly, Applicants submit that claims 30, 33, and 34 are patentable over Pierre, Belli, Castellani and the '027 patent. The 35 U.S.C. § 103(a) rejection of claims 30, 33, and 34 as being unpatentable over Pierre, Belli, Castellani, and the '207 patent is improper, and should be withdrawn.

C. The Office continues to reject claims 31 and 32 under 35 U.S.C. § 103(a) as being unpatentable over a combination of Pierre, Belli, Castellani, and WO 03/088274 to Belli et al. ("WO '274") for the reasons of record. *See* April 10, 2009, Final Office Action at 7 and 9-10.

Applicants respectfully disagree with and traverse this rejection for at least the reasons of record, as well as the following additional reasons.

As discussed above, Pierre, Belli and Castellani fail to disclose each and every element of independent claim 20, whether considered alone or in combination. In particular, those references fail to teach or suggest a that "operates continuously from the feeding step through the forming step without any intermediate resting or collecting steps[,]" and which included "forming a circumferentially closed metallic screen around said extruded insulating layer" after cooling the extruded insulating layer, as recited in claim 20.

WO '274 does not cure these deficiencies, as tacitly admitted by the Office's reliance on the disclosure of WO '274 patent for other purposes. Accordingly,

Applicants submit that claims 31 and 32 are patentable over Pierre, Belli, Castellani and WO '274. The 35 U.S.C. § 103(a) rejection of claims 31 and 32 as being unpatentable over Pierre, Belli, Castellani, and WO '274 is improper, and should be withdrawn.

D. The Office continues to reject claim 35 under 35 U.S.C. § 103(a) as being unpatentable over Pierre, Belli, Castellani and U.S. Patent No. 6,416,813 to Prats ("Prats") for the reasons of record. *See* April 10, 2009, Final Office Action at 7-8 and 9-10.

Applicants respectfully disagree with and traverse this rejection for at least the reasons of record, as well as the following additional reasons.

As discussed above, Pierre, Belli and Castellani fail to disclose each and every element of independent claim 20, whether considered alone or in combination. In particular, those references fail to teach or suggest a that "operates continuously from the feeding step through the forming step without any intermediate resting or collecting steps[,]" and which included "forming a circumferentially closed metallic screen around said extruded insulating layer" after cooling the extruded insulating layer, as recited in claim 20.

Prats does not cure these deficiencies, as tacitly admitted by the Office's reliance on the disclosure of Prats for other purposes. Accordingly, Applicants submit that claim 35 is patentable over Pierre, Belli, Castellani and Prats. The 35 U.S.C. § 103(a) rejection of claim 35 as being unpatentable over Pierre, Belli, Castellani, and Prats is improper, and should be withdrawn.

E. The Office continues to reject claim 38 under 35 U.S.C. § 103(a) as being unpatentable over a combination of Pierre, Belli, Castellani, and WO 2002/047092 to Belli et al. ("WO '092"). *See* April 10, 2009, Final Office Action at 8-9 and 9-10.

Applicants respectfully disagree with and traverse this rejection for at least the following reason.

As discussed above, Pierre, Belli and Castellani fail to disclose each and every element of independent claim 20, whether considered alone or in combination. In particular, those references fail to teach or suggest a that "operates continuously from the feeding step through the forming step without any intermediate resting or collecting steps[,]" and which included "forming a circumferentially closed metallic screen around said extruded insulating layer" after cooling the extruded insulating layer, as recited in claim 20.

WO '092 does not cure these deficiencies, as tacitly admitted by the Office's reliance on the disclosure of WO '092 for other purposes. Accordingly, Applicants submit that claim 35 is patentable over Pierre, Belli, Castellani and WO '092. The 35 U.S.C. § 103(a) rejection of claim 35 as being unpatentable over Pierre, Belli, Castellani, and WO '092 is improper, and should be withdrawn.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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